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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,336	05/04/2001	Shinichi Suwabe	040405/0337	6759

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EXAMINER
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BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/848,336	SUWABE, SHINICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/20/2004</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "131" has been used to designate both INPUT UNIT and SEND. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 3-i (Page 29), 132 (Page 31), and 24a (Page 24a). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 13-n (Figures 1 and 12), 14-n(Figure 1), 31-n (Figures 1 and 12), 32-n (Figures 1 and 12), 12-na (Figures 12), and 14-na (Figures 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Examples of hard to understand terminology include (but not limited to): the item name being notified by a panel device (Claim 7, Lines 13-15) and the sending/receiving unit (does it send, or does it receive) (Claim 4, Line 40). The following terms are confusing to the examiner: "item", "item list", "item name", and "item content" (Claims 7, 17, and 27). These terms all appear to refer to the same thing and the examiner will consider them as such. Claims 3, 6, 13, 16, 23, and 26 recite the limitation "adds the control information" in the second portion of the claims under "advertisement panel control terminal". There is insufficient antecedent basis for this limitation in the claim. Claims 4, 14, and 24 recite the limitation "for portable unit" in the third portion of the claim in the sentence "a sending/receiving unit for portable unit". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**7. As best understood, claims 1-3, 11-13, and 21-23 are rejected under 35**

**U.S.C. 102(e) as being anticipated by Unold (U.S. Pub. No. 2002/0055880).** Unold

shows an information display system that includes all of the limitations recited in the above claims.

Unold teaches an electronic advertisement display system (abstract) having the following: an advertiser telecommunication device (shop terminal) connected via the Internet for requesting to register (Paragraph 0009, Sentences 2-3), update (Paragraph 0051), and send advertising information to the server computer (Paragraph 0051); a server computer (advertisement panel control terminal) for registering (Paragraph 0062, Sentence 2), controlling (Paragraph 0070, Sentence 1), and updating (modification) (Paragraph 0051, Sentence 2) the advertisement information, sending the advertisement information to the display device (Paragraph 0047, Sentence 3), and registering information relating to the display device that will display the advertisement (if an advertiser can register at different sites, it is inherent that the system will keep track of where the advertisement is meant to be shown) (Paragraph 0008, Sentence 2); and an advertisement panel display device for displaying an advertisement (Paragraph 0047, Sentence 3).

***Claim Rejections - 35 USC § 103***

**8. As best understood, Claims 4-8, 14-18, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unold (U.S. Pub. No. 2002/0055880) in view of Whiteside (U.S. Patent No. 5,835,861).**

Unold teaches an electronic advertisement display system (abstract) having the following: an advertiser telecommunication device (shop terminal) connected via the Internet for requesting to register (Paragraph 0009, Sentences 2-3), update (Paragraph 0051), and send advertising information to the server computer (Paragraph 0051); a server computer (advertisement panel control terminal) for registering (Paragraph 0062, Sentence 2), controlling (Paragraph 0070, Sentence 1), and updating (modification) (Paragraph 0051, Sentence 2) the advertisement information, sending the advertisement information to the display device (Paragraph 0047, Sentence 3), and registering information relating to the display device that will display the advertisement (if an advertiser can register at different sites, it is inherent that the system will keep track of where the advertisement is meant to be shown) (Paragraph 0008, Sentence 2); an advertisement panel display device for displaying an advertisement (Paragraph 0047, Sentence 3) and sending detailed information to a portable unit (Paragraph 0052); and a portable unit (consumer telecommunication device) for sending a request for and displaying detailed information from the display device (Paragraph 0052). Unold also teaches detailed information as consisting of a plurality of items (Paragraph 0052). Unold further teaches the sending of an item list to a portable unit for display and

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eventual selection of an item by a consumer (Paragraph 0052). Unold doesn't specify the interaction of sending and receiving as taking place between the wireless device and the display device. Whiteside teaches a wireless device that is capable of receiving information and sending information to a billboard (Column 1, Lines 28-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have Unold's device interact directly with the display device. This would allow greater accessibility for wireless devices having short-range signals.

**9. As best understood, Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unold (U.S. Pub. No. 2002/0055880) in view of Whiteside (U.S. Patent No. 5,835,861) and further in view of Giraud (U.S. Patent No. 5,966,696).**

Unold doesn't specify the storing of a user's access history at a server computer. Giraud teaches an advertising display system that tracks the number of times advertisements were presented to potential customers and stores them in a host computer (Column 2, Lines 14-18 and 24-28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store access history at a server computer. This would allow for marketing strategies to be formulated based on consumer interests.

**10. As best understood, Claims 10, 20, and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Unold (U.S. Pub. No. 2002/0055880) in view of Whiteside (U.S. Patent No. 5,835,861) and further in view of Hollenberg (U.S. Patent No. 6,091,956).**



Unold teaches the purchase items by consumers through the use of a portable device in communication with the advertisement display device (Paragraph 0052).

Unold doesn't specify the ability to make reservations. Hollenburg teaches a portable device with the ability to view hotel vacancies and send email to negotiate a reservation (Column 6, Lines 38-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made that a consumer could use Hollenburg's device to communicate with the advertisement display system. This would allow users to make hotel reservations without physically being at the hotel.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to advertisement display devices:

U.S. Patent No. 6,879,285 to Nobukiyo

U.S. Patent No. 5,844,181 to Amo

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB



**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**